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09/786.610	03/06/2001	Jean-Bernard Mabon	PD980061	1467

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EXAMINER

KOSTAK, VICTOR R

ART UNIT

PAPER NUMBER

2611

5

DATE MAILED: 06/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/786,610

Applicant(s)
Mabon

Examiner
Victor R. Kostak

Art Unit
2611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle* 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application
- 4a) Of the above, claim(s) 14 is/are withdrawn from consideration
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 15-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirements

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3 6) ☐ Other: _____

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1. The drawings are objected to because all block circuitry (noting particularly Fig. 3) must be functionally labeled in compliance with rules 83(a) and 84(o). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.
2. The following guidelines illustrate the preferred layout and content for patent applications. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

The following order or arrangement is preferred in framing the specification and, except for the reference to the drawings, each of the lettered items should appear in upper case, without underling or bold type, as section headings. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) Title of the Invention.
- (b) Cross-Reference to Related Applications.
- (c) Statement Regarding Federally Sponsored Research or Development.
- (d) Reference to a "Sequence Listing," a table, or a computer program listing appendix submitted on compact disc (see 37 CFR 1.52(e)(5)).

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(e) Background of the Invention.

1. Field of the Invention.
2. Description of the Related Art including information disclosed under 37 CFR 1.97 and 1.98.

(f) Brief Summary of the Invention.

(g) Brief Description of the Several Views of the Drawing(s).

(h) Detailed Description of the Invention.

(I) Claim or Claims (commencing on a separate sheet).

(j) Abstract of the Disclosure (commencing on a separate sheet).

(k) Drawings.

(l) Sequence Listing, if on paper (see 37 CFR 1.821-1.825).

3. Claim 14 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim must be in the alternative only. See MPEP § 608.01(n). Accordingly, the claim has not been further treated on the merits.

4. Claim 1 provides for the use of channel storage, but, since the claim does not set forth any steps involved in the method/process in the active tense, it is unclear what method/process applicant is intending to encompass. *A claim is indefinite where it merely recites a use without*

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any active, positive steps delimiting how this use is actually practiced. Dependent claims 2-19 also recite steps in the narrative rather than in the active tense.

Claims 1-13 and 15-20 are accordingly rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966). See also *Ex parte Erlich*, 3USPQ2d 1011 at 1017.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 7, 19 and 20 are further rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "short, "medium" and "long" in claim 7 are relative terms which render the claim indefinite. The terms are not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

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Regarding claim 19, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim 20 is at least ambiguous if not misdescriptive because the duration period does not actually "fall below" a period, but instead does not reach or meet that period.

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6, 8, 9, 12, 13, 19 and 20 (viewed as reciting steps in the active form) are rejected under 35 U.S.C. 102(b) as being anticipated by Keenan.

The tuning system of Keenan (noting Fig. 1) carries out a "favorite channel" assignment operation (noting Fig. 5), in which when a channel is (and/or subsequent channels are) received through the use of a remote controller, the user holds the channel tuned for a duration exceeding a preset three-second period which then stores the channel as a favorite channel (note steps 515, 540, 550 and 570), favorite channels being channels of interest, thereby meeting claim 1.

As for claim 20, those channels not reaching the three-second period are not stored.

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As for claim 2, the reception duration period (i.e. the three-second time interval) is determined as a permanent period for determining favorite channels.

As for claim 3, the duration of a received channel is only determined when that channel is in fact received (and not skipped), as a result of the three-period time interval being exceeded, the channel thereafter being accessed for viewing.

Regarding claim 4, the reception of a channel is a result of switching from a previous channel (noting the up/down step 515).

As for claim 5, the three-second period is set by the manufacturer (i.e. the timer functions, col. 3 lines 7-19).

As for claim 6, various time intervals included separate three-second periods for channel storage and channel access operations (noting Figs. 3 and 5).

Considering claim 8, when the reception duration of a current channel is determined not to exceed the three-second interval, and a subsequent channel does exceed the interval, the channel held longer period (i.e. the one exceeding the three-seconds) is stored.

As for claim 9, all of the channels exceeding the three-second period are accordingly stored, which is the purpose of Keenan.

As for claim 12, Keenan uses a remote controller 128 to change channels.

Regarding claim 13, an up/down key is used to progress or regress along the channel frequency bands.

As for claim 19, channel-specific data is also stored (col. 4 lines 25-29).

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7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Keenan.

Regarding the display of picture-type data relating to the channels of interest (favorite channels), it would have been obvious to one of ordinary skill in the art to list the channels in pictorial, textual or in an otherwise viewable format to the viewer in order to provide ready and compact representation of the customized channel listing, as suggested by the OSD capabilities of Keenan (col. 3 lines 1-6) and the channel list shown as RAM stored data (Fig. 4; col. 5 lines 13-28).

8. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Keenan in view of Rzeszewski et al.

It would have been obvious to one of ordinary skill in the art to take advantage of well known PIP display when plural programs are desired to be viewed simultaneously, as taught by Rzeszewski, who also incorporates favorite channel feature (e.g. Fig. 4).

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9. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Keenan in view of Yee et al.

Yee points out that any suitable channel selection input device can be used in a television receiver and mentions a remote controller and a voice-activated device as examples, (element 10; col. 7 lines 21-24). In view of this explicit teaching and the ready selection and availability of such devices, it would therefore have been obvious to use a voice-activated controller in the system of Keenan, as allowed by Yee.

10. Claims 1, 9-11 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Jang (cited provided by applicant).

Jang (any one of Figs. 2-4) first stores channel data based on preferences (which inherently includes a minimum time period required for recognizing the channels of interest accessed by the up/down key of remote keypad 10), thereby meeting claim 1.

As for claim 20, those channels not selected accordingly do not meet the minimum time threshold for activating storage.

As for claim 9, all of the channels selected to be stored (i.e. preferred channels) are accordingly stored, such being the purpose of Jang.

Regarding claims 10 and 11, respective channel durations are also stored (steps, not labeled, shown in the lower right of each flow chart), reflecting the relative degrees of interest.

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11. Claims 6 and 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jang.

Although not specified, since Jang can store different channels having characterized by durations of different reception lengths (which indicate degrees of interest), it would have been obvious to one of ordinary skill in the art to experience programs on different channels which exhibit different (or various) times periods.

Likewise regarding claim 7, it would have been obvious to select any suitable amount of channels, such as three, and if all of the durations differ, they would be categorized as a shortest of the three, a longest of the three, and the third lying in between the two.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor R. Kostak whose telephone number is (703)-305-4374. The examiner can normally be reached on Monday through Friday from 6:30am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew I. Faile, can be reached on (703) 305-4380. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone (703) 306-0377.

Any response to this action should be mailed to:

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Commissioner of Patents and Trademarks

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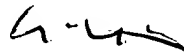
or faxed to:

(703) 872-9314 (For either formal or informal communications intended
for entry. For informal or draft communications, please label
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal
Drive, Arlington, VA., Sixth Floor (Receptionist).

Victor R. Kostak

Primary Examiner



VRK

6/12/03